

## REMARKS

### Amendments

Please enter into the record the amendments to the claims set out above. The proffered amendments either cancel claims or are editorial in nature, neither type of amendment requiring any new searching or constituting a possible new ground of rejection.

### Claim Rejections

#### Claim Rejection under 35 USC §112, 2<sup>nd</sup> ¶

Claim 9 has been rejected under §112, 2<sup>nd</sup> ¶ as: i) lacking defined product(s) for steps (a), (b), (c) and (g); ii) a possible deficiency in the term “Formula (I)””; and iii) and an alleged uncertainty with regards to the meaning of “the activated compound of formula (III)”. In a corollary holding, claims 10-12 have been rejected as depending on claim 9.

As applicants have cancelled claim 9-12 herein above, this rejection is moot.

#### Claim Rejection under 35 USC §112, 1st ¶

Claim 41 and 42 have been rejected under 35 USC §112, 1st ¶ on the basis of lack of enablement in the specification for treating all diseases that may be treated by inhibiting the PDE 4 receptor. This rejection seems most applicable to claim 41, as claim 42 names one specific disease, atopic dermatitis.

Applicants have amended claim 41 to read on treating or using as a prophylactic the named compound where atopic dermatitis is present or may develop. These uses of said compound are set out in the Background section of the specification on page 1, lines 10-13. In conjunction with the amendment to claim 41, claim 42 has been cancelled. These amendments should, in the applicants’ view, address the concerns raised by the examiner with regards to enablement.

#### Rejection - Double Patenting of the Obviousness Type

Claims 2-3, 6-8, 26-27, and 35-42 have been provisionally rejected under the judicially created doctrine obviousness-type double patenting in light of co-pending application USSN 10/598,973. The examiner refers specifically to claims 33-41 and 43-58 of that application. That application is pending.

Applicants wish to bring to the examiner’s attention co-pending application USSN 12/013,529. The generic formulation in this case could possibly be read to encompass the compound of the instant claim set.

Transmitted herewith is a terminal disclaimer, signed by applicants’ representative, disclaiming the term of any patent issuing from this application over the term of a nascent

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patent that may be granted or which derives its parentage from USSN 10/598,973 or USSN 12/013,529.

Conclusion

Please enter into the record the amendments set forth herein above. All of the issues raised by the Examiner have been addressed. If any issues remain to be resolved in the application, the Examiner is invited to contact the undersigned at the number provided. Allowance of the remaining claims is requested.

Respectfully submitted,

/JamesMKanagy/

James M. Kanagy  
Attorney for Applicants  
Registration No. 29,550

GLAXOSMITHKLINE  
Corporate Intellectual Property - UW2220  
P.O. Box 1539  
King of Prussia, PA 19406-0939  
Phone (610) 270-5014  
Fax (610) 270-5090